

Remarks/Arguments:

Claims 1-28 are pending in this application. Claims 1-13 are allowed and claims 14-28 are rejected.

Claims 14-28 stand rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,133,732 ("Wiktor"). Applicants respectfully traverse these rejections and submit that the pending claims are patentable over the art of record for at least the reasons set forth below.

Response to Prior Art Rejections of Independent Claims 14 and 25

This response includes arguments in the following paragraphs that were presented in the Office Action response dated February 13, 2006. Additionally, however, Applicants have provided additional grounds with respect to those arguments, specifically to address the comments provided in the Advisory Action dated March 16, 2006.

The Office Action rejects independent claims 14 and 25 under § 102(b) based on Wiktor. Applicants respectfully submit, however, that the claimed invention includes structural features that are readily distinguishable from those disclosed by Wiktor. As noted in Applicants' Office Action response dated September 19, 2005, Applicants' invention, as recited by independent claims 14 and 25, includes features which are neither disclosed nor suggested by the art of record, namely, in claim 14: "wherein at least one apex section comprises two struts attached thereto with one strut longer than the other strut, in which for each apex section comprising one strut longer than the other, **the two struts lie on a common cylindrical surface having a common radius relative to a longitudinal axis of the stent**" (emphasis added); and claim 25: "**the non-uniform apex sections and the generally uniform apex sections all lying on a common cylindrical surface having a common radius relative to a longitudinal axis of the stent.**" (emphasis added).

In addressing Applicants' September 19, 2005 Office Action response, the Office Action merely states that the anticipation rejection of the claims is proper because "Wiktor disclose[s] a stent that [is] made from wrapping the wire (2) around a cylindrical mandrel," therefore, the stent would inherently have "the two struts lie on a cylindrical surface having a common radius relative to a longitudinal axis of the stent." (See Office Action, page 2). While this is true with respect to Applicants' invention, it certainly cannot be the case of Wiktor, particularly with respect to the embodiment of Wiktor cited by the Office Action.

With the rejection of each of claims 14-28 based on the reasoning of the Office Action, the Office Action ignores the express teaching of Wiktor, in particular with respect to the embodiment to which the Office Action cites. As discussed in Wiktor, with reference to Figure 8, the "elongated waves 48 are bent to form a loop or hook 50. Each hook is looped over a wave 46 adjacent." (col. 7, lines 20-21). Because the waves are bent to form the hooks 50 that are looped over adjacent waves, it is not possible for Wiktor to inherently include two struts (or waves) that lie on a cylindrical surface having a common radius relative to a longitudinal axis of the stent. This is because the act of *bending* wave 48 to form hook 50 creates new apex sections in the middle of the wave, each having struts on different radii relative to the longitudinal axis. (See the attached copy of the Wiktor Patent Fig. 8, which has been annotated to reflect what the Applicants believe is the Examiner's reading of the reference to support the rejection.) Such *bending* of waves 48 is required to allow hooks 50 to engage adjacent waves 46 as taught by Wiktor. Thus, as shown in Figure 8, the short struts jut radially outward relative to the long struts and consequently, the long and short struts cannot inherently lie on a common cylindrical surface having a common radius relative to the longitudinal axis.

Applicants also contend that if, on the other hand, the Office Action is ignoring the new apex sections formed by bending to make the hook, and referring only to the apex section at the very end of the struts that have been bent in the process of forming the hook (the "hook apex sections"), then the stent apex sections cannot be construed to be "alternately pointing in opposite axial directions" as is expressly required by independent claims 14 and 25, because the hook apex sections point in the *same direction* as the adjacent apex sections.

In response to the above-noted arguments, Applicants received an Advisory Action dated March 16, 2006. The Advisory Action states that the arguments presented in the Response filed February 13, 2006, are not persuasive because: "Applicant has argued that the act of bending the waves positions the struts in separate planes. Examiner has considered this argument but disagrees, while the act of bending the [sic] could cause the struts to fall into differing planes the waves could also be bend [sic] in such a fashion which allows both struts to fall in the same plane." Applicants' attempts on April 12, 2006, to schedule an Examiner Interview to discuss the Advisory Action with the Examiner were denied.

The Advisory Action's reasoning for maintaining the claim rejections is based on speculation and conjecture that the act of bending *could* cause both struts to fall "in the same plane," not from what is taught, disclosed or suggested by Wiktor. Wiktor, specifically Figure 8

and its accompanying text, does not teach, disclose or suggest "the bending of waves in such a fashion which allows both struts to fall in the same plane," as asserted in the Advisory Action. Wiktor teaches in col. 7, lines 20-21, that "elongated waves 48 are bent to form a loop or hook 50. Each hook is looped over a wave 46 adjacent." This description, when combined with the illustration in Fig. 8 in which the waves have been bent in such a way that the relevant struts clearly do not lie on a "cylindrical surface having a common radius relative to a longitudinal axis of the stent," as claimed by the Applicants, would not lead one skilled in the art to construct a stent with the Applicants' claimed limitations.

The mere possibility that the waves could be bent in a way that the struts fall in the same plane (or on a common cylindrical surface, as specifically claimed), even if true, is not the proper basis for an inherent anticipation rejection. "The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112 (emphasis in original). *See also, Mehl/Biophile Int'l Corp. v. Milgraum*, 52 USPQ2d 1303 (Fed. Cir. 1999) ("The possibility of [the claimed] alignment [in the prior art reference] does not legally suffice to show anticipation."); *Rosco, Inc. v. Mirror Lite Co.*, 64 USPQ2d 1676 (Fed. Cir. 2002) (reversing district court's holding of invalidity because inherency requires that the missing descriptive material be "necessarily present," not merely probable or possibly present, in the prior art) (citations omitted).

Not only is there a complete absence of any inherent or explicit disclosure of the Applicants' claimed invention in Wiktor, but there is also no motivation to modify Wiktor to bend the waves in such a contorted manner that the relevant struts would lie on the same plane. The Office has not even provided any evidence from a technical standpoint, of how such bending could be performed. It is mere speculation that the act of bending the waves in the Wiktor device inherently could allow both struts to fall in the same plane and still provide each hook 50 looped over adjacent wave 46, particularly when Fig. 8, the only illustration that defines the "hook or loop" disclosed by Wiktor, does not show such a configuration. Certainly, the Advisory Action provides no "basis in fact or technical reasoning to support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of [Wiktor]" to support its position. M.P.E.P. § 2112 (emphasis in original) (*citing Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

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In short, Wiktor clearly does not anticipate the claim language, and the Office has articulated nothing other than hindsight in light of the Applicants' disclosure, that could support even an obviousness rejection based upon Wiktor.

Therefore, Applicants contend that the rejections of both the final Office Action and the Advisory Action are based on improper applications of the law and because the rejections find no support in the reference or from any fact or technical reasoning on the record.

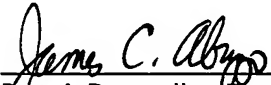
Applicants respectfully submit, that independent claims 14 and 25 are patentable over Wiktor. Claims 15-24 and 26-28 are also patentable over Wiktor at least for the same reasons that claims 14 and 25, on which they are dependent, are patentable, but may be separately patentable for additional reasons as well.

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Conclusion

In view of the arguments set forth above, Applicants contend that claims 14-28 are in condition for allowance. An interview with the Examiner in charge of this application is requested to discuss any remaining issues which might preclude a Notice of Allowance.

Respectfully submitted,



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Attachments: Wiktor Patent Figure 8 (annotated)

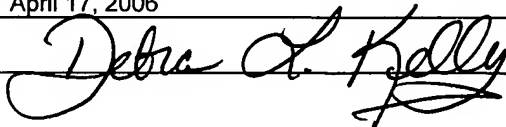
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